
IN THE
United States
Circuit Court of Appeals
 FOR THE NINTH CIRCUIT.

Riverside Heights Orange Grow- ers' Association, a corporation, and George D. Parker, <div style="text-align: right;"><i>Appellants,</i></div>	<i>vs.</i>	Fred Stebler, <div style="text-align: right;"><i>Appellee.</i></div>
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No. 2772.
 On Appeal by Defendants
 From Final Decree.

BRIEF ON BEHALF OF COMPLAINANT-APPELLEE.

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This appeal comes before this court to review a final decree entered October 30, 1915 [Transcript pages 339-340], confirming the report of the special master appointed by the interlocutory decree ordered by this court in complainant's favor for the relief prayed in the bill of complaint.

Necessarily the first thing to be ascertained is: What is to be reviewed?

Had defendants filed no exceptions to the master's report, none of the findings of the master and none

of the proceedings before the master would be open to review by this court.

It is necessary, therefore, to first ascertain to what finding or findings of the master or what proceeding by the master were properly brought by defendants before the District Court for review, for the review in this court cannot be, with respect to matters not properly challenged or excepted to in the court below, in accordance with the law and equity rules. If the defendants' assignments of error seek a review of a finding or findings by the master which were not challenged or not properly excepted to to bring the same before the District Court for review, then such matters are not before this court for review.

The exceptions filed in the District Court by defendants are set out on pages 331-333, and refer *solely* to the consideration and determination by the master that twenty (20) graders of a modified construction were infringements. Such graders were manufactured and sold by defendant Parker (some of which were used by defendant Riverside Heights Orange Growers' Association) after the interlocutory decree and the service of the writ of injunction upon defendants.

This is clearly the purport and intendment of these two exceptions. The first of these exceptions is as follows:

“First Exception: For that the said master, in his said report on file herein, has found that since the date of the interlocutory decree entered in the above-entitled suit on the seventh day of November, 1913,

one of the defendants herein, to-wit, George D. Parker, by the manufacture and sale of a differently constructed apparatus to the one adjudged to have infringed complainant's reissue letters patent No. 12,297, has further infringed the plaintiff's said patented device, and found that for such new machines the said defendant—George D. Parker—was liable unto the plaintiff for profits derived therefrom, and in addition thereto for damages unto the said complainant, whereas the said master, under the evidence presented and in accordance with the law, should have found and reported unto this Honorable Court that the said device, specifically referred to on pages 3, 4, 5, 6 and 7 of the said report, so manufactured and sold by the said defendant—George D. Parker, since the said seventh day of November, 1913, was substantially a different machine from the Parker machine held by the court herein to have been an infringement of the complainant's said patented device, and that the same was not and did not constitute an infringement of the said reissue letters patent No. 12,297, and should not have allowed any profits and damages unto the complainant by reason of the said manufacture and sale of the said new fruit grader so manufactured and sold by the defendant, George D. Parker, since the date of the said interlocutory decree herein."

Nothing could be clearer than that this "First Exception" challenges solely and only the finding that these graders manufactured, sold and used after the service of the injunction, infringe either claim 1 or 10 of the reissue patent in suit.

Defendant filed only two exceptions to the master's report. The other is:

“Second Exception: For that the said master, in his said report, found that the plaintiff should recover from the defendant, George D. Parker, the sum of \$5,232.85, as gains and profits, and an additional sum of \$6,237.35 as damages, or a total amount of \$11,470.20, as profits, gains and damages due unto the plaintiff herein, whereas the master should have found and reported the liability of the defendant unto the plaintiff limited to the gains, profits and damages found from the evidence herein resulting from the machines manufactured and sold by the defendant, George D. Parker, and held by the court herein to have been an infringement of the plaintiff's reissue letters patent No. 12,297.”

This exception challenges the right and duty of the special master to consider and determine the question whether these subsequent graders infringe. This exception points out no other error and asks review only of defendants' contention that “the master should have * * * limited” his consideration and report to “the machines” * * * “held by *the court* herein to have been an infringement of the patent in suit. Any other construction would render the exception bad as duplicitous and uncertain. The clear intendment of this exception was solely to challenge the action of the master in considering and determining the subsequent machines to infringe and awarding profits or damages therefor.

If it be attempted to construe this second exception

as referring both to the machines “held *by the court* herein *to have been* an infringement” and also to the machines determined by the master to be an infringement, then all that portion of the exception including and following the word “whereas” is mere surplusage and idle words. This cannot be the true construction. The true construction very clearly depends on the word “limited” and upon all the words following. If not limited, as now insisted upon by complainant, the exception is bad. It is too general, too ambiguous, and does not distinctly point out the alleged error to which the exception is directed.

In *Sheffield Co. v. Gordon*, 151 U. S. 285, 290, the court says:

“Proper practice in equity requires that exceptions to the report of a master should point out specifically the errors upon which the party relies.”

In *Street’s Federal Equity Practice*, Vol. 2, § 1475, it is said:

“It is frequently said that exceptions to a master’s report are in the nature of a special demurrer. This statement is true in so far as it is taken to imply that the exceptions must be specific and that they lie only upon matter contained in the report or in the papers and proof on which the report is based and which are referred to in it. A more helpful analogy, perhaps, is that which would liken the exceptions to an assignment of errors upon appeal or writ of error to a higher court.”

“It is an elementary rule of equity procedure that exceptions to a master’s report must point out

specifically the error, or errors, relied upon by the party excepting to the report.”

Street’s Fed. Eq. Pr., Vol. 2, § 1485;

Sandford v. Embry, 151 Fed. 977, 983;

Story v. Livingston, 13 Pet. 369.

It is submitted, therefore, that defendant’s exceptions to the master’s report raised only two questions for review :

1. Alleged error by the master in considering and determining whether the subsequent or modified graders infringed, and in finding that they did infringe.

2. In awarding profits and damages on both the Parker patented type of grader, *held by the court* to infringe, and the subsequent or modified type, held by the master to infringe, and in not limiting the award to the Parker patented type.

It is further submitted that upon an appeal from the order or decree of the District Court sustaining the master’s report, not matters or things could be assigned as error which are not pointed out in the exceptions to the master’s report. In other words, the assignments of error on this appeal can only be two, i. e. : (1) That the court erred in overruling defendants’ first exception; (2) that the court erred in overruling defendants’ second exception.

The assignments of error [Tr. pp. 344-345] attempt to challenge not only the consideration by and finding of the master that the defendants’ subsequent or modified machines infringed and the award of the master

of profits and damages on account of such subsequent infringement, *but also* attempt to challenge the master's findings as to profits and as to damages arising from the manufacture, use and sale by defendants of the Parker patent type of machines, held by this court to be an infringement, and to which defendants' second exception to the master's report claims the accounting must be "limited."

Complainant therefore submits that defendants are not in a position to urge or ask consideration in this court of their second or third assignments of error, and that review in this court can be asked only of the questions challenged by the exceptions to the master's report and to the action of the District Court in allowing damages under sections 4919 and 4921 of the Revised Statutes upon the theory that the defendants have been wilful infringers and stubbornly litigious. This last allowance will be found to rest in the sound discretion of the trial court.

This was the interpretation and construction placed upon defendants' exceptions to the report of the special master, not only in the argument in the District Court but in the brief submitted by defendants' counsel, as appears from the following quotation from defendants' brief filed on the hearing of the exceptions to the master's report in the District Court:

"On behalf of the defendant, two exceptions have been taken to the master's report, each of which involve the question as to whether or not the defendant is liable unto the complainant for the manufacture and sale of the new fruit grader placed on the market by

the defendant since the entry of the decree in the present case.”

Infringement by Modified Forms of Parker Grader.

The history of this litigation prior to the accounting is set forth in the opinion of this court, reported in 214 Fed. 550; the opinion of this court finding the Robert Strain reissue patent number 12,297 (sued on herein) valid and infringed and interpreting and construing the same, is found in 205 Fed. 735.

This matter, therefore, comes before the court at this time in the following condition:

The validity of the patent in suit and of the claims sued on (to-wit, 1 and 10) have been finally determined by the court of last resort and such matters are *res adjudicata* between the parties. The court of last resort has construed the patent and claims one and ten thereof and defined the character of the invention produced by Robert Strain and its scope. Such adjudication and definition is *res adjudicata* between the parties. It is submitted that it was the duty of the special master and of the District Court to follow the interpretation thus placed thereon by this court, for such interpretation and construction were not only *res adjudicata* but the law of the case.

The position of complainant with respect to the modified forms of Parker grader as infringements is exactly the same as complainant's position with respect to the so-called Parker patent type of infringing grader. This is illustrated and made apparent by reference to appellant's (complainant's) opening and reply

briefs in the Circuit Court of Appeals, upon which appeal the decision in 205 Fed. 735 was rendered

In short, complainant's position there, as now, may be stated to be as follows:

Robert Strain's inventive idea was the provision of means whereby each grade opening or discharge opening in a fruit sizer or grader might be rendered within the control of the operator without the necessity of the operator co-incidentally changing or altering any adjacent discharge opening or grade opening. As pointed out in complainant's opening brief on said appeal, and as found by this court in 205 Fed. 735, the old Ish patent or California grader contained the "long horizontal roller, with graduated sections or steps, "turned down from a larger diameter to a smaller one, "resembling an inverted telescope; and a flat endless "belt, so adjusted that it was longitudinally parallel "with the axis of, but a little lower than, and with a "slight lateral inclination from the horizontal toward, "the roller." (205 Fed. 736.)

With such a grader the operator could not adjust or change one of the grade openings or sizing openings without affecting the size of an adjacent grade or discharge opening. This was found to be the fact by this court and is conclusively proven by the unanimous agreement of the testimony of all the witnesses in the case. See appellant's opening brief in the Court of Appeals (case 2232), pages 61 to 63, where will be found a digest of the testimony in this respect.

Complainant urged upon the Court of Appeals that the Robert Strain invention did not reside in details

of construction; that it was a highly important invention and one of material scope; that it belonged to that class of inventions where conception of the inventive idea by the inventor was what was lacking in the prior art; that given this inventive idea any mechanic could embody the invention in a number of different forms. This court said: "The invention, we think, was an "important and distinct advance in the art and is not "anticipated by former patents." We thus find that this court has adopted complainant's view, to-wit, that the invention resided in the broad conception of the necessity for and a means of securing control by the operator of each discharge or grade opening without affecting the adjacent discharge opening or grade opening. The language just used in this brief will be seen to avoid the use of the word "independent." The term "independent" as used in complainant's briefs and in this court's opinion means this: that such adjustment of a given grade opening or discharge opening is "independent" of the other grade opening *in the sense* that the adjusting of one grade or discharge opening does not affect the size of fruit discharged from the adjacent discharge or grade opening. That is the kernel or essence of Robert Strain's invention. It is obvious that many ways may be employed for securing this highly advantageous interrelation of parts and result. This court says, in referring to Robert Strain's invention, "the essence of which is the combination "with a traveling belt (common to the Ish, Strain, and "Parker machines) of a series of independent rotating "units arranged in longitudinal succession parallel with

“the belt, each transversely adjustable.” The defendants harp upon the term “independent” as thus used by the Court of Appeals. Complainant submits that in construing this language or finding it should be construed in the same manner as any other instrument, to-wit, attention should first be given to what is the object to be secured. It is clearly apparent that whether the “independent rotating units” are mechanically driven by means of belts, or simply allowed to rotate by the action of the fruit, is immaterial, for this court held that the Parker patent type of grader infringed, although the rollers thereof had no driving belts or driving means. It is true that in the drawings of the Strain patent he has shown a cross belt for each roller section, but the means of driving has nothing whatever to do with the transvers adjustment of each unit toward and away from the belt to secure the adjustment of the discharge opening formed between such belt and such roller section, and it is immaterial whether the entire length of the roller side of the fruit runway formed by the series of rollers and belt, turns in synchronism or at different speeds, or whether such rotation is by means of the fruit, or by means of one and the same rotative power or element or by different rotative powers or elements, and the term “independent” as thus used by the Court of Appeals does not refer to an independence as to rotation, but to an independence of the rotating units *as to operative adjustment* toward and away from the belt *to form the operative* grade opening or discharge opening. In other words, the word “independent” as thus used by this

court refers to that feature which embodies the inventive idea set forth in the Strain patent, to-wit, an adjustment of the rotating units "independent" of each other in the sense that the grade opening or discharge opening formed between such rotating unit and the belt may be controlled by the operator without affecting the size of fruit discharged through an adjacent discharge opening or grade opening.

It is well known that a given "invention" may be variously embodied in machines for a given purpose. That no two mechanics will select exactly the same devices for doing a given thing in a machine. An inventor is only required to show in his drawings or describe one form in which his invention may be embodied.

In this connection it is to be borne in mind that in the particular embodiment of the Robert Strain invention illustrated in the drawings in the patent in suit and described in detail therein, while the roller sections are with adjustable means at each end so that each roller is mounted totally free from connection with the preceding or succeeding roller, still the grading opening or discharge opening is formed at the end of the roller toward the feed end of the machine and the end away from the feed end of the roller performs no function in grading, being simply a wall along which the fruit passes, all of the fruit that will be discharged being discharged in the first third of the roller and between the roller and the belt. In this respect corresponding exactly with the functions of the roller sections in the so-called modified Parker ma-

chines, and this rear end portion of the roller sections is merely idle or non-grading space in both the embodiment of the invention shown in the drawings of the Strain patent and in the modified Parker machines. This is the same idle space that is referred to by this court on page 739 of 205 Fed., where the court refers to the Parker patent type of grader and says:

“The guide arms and the rollers thus form one continuous side or wall of the runway.”

and

“So far as the sorting or separating of the fruit into desired sizes is concerned, precisely the same result is reached by the use of the same means operating in the same manner. The truth of this proposition is strikingly illustrated in appellant’s brief by a cut of defendants’ machine as it appears with the guide arms eliminated and the several roller units brought into close proximity.”

See appellant’s reply brief (case 2232), page 20.

This illustrates the fact that this court found the inventive idea of Robert Strain to exist in the control of the respective grade openings or discharge openings (formed between the roller sections and the traveling belt) by the operator at his will without affecting the size of fruit discharged through the adjacent grade opening or discharge opening, and the Court of Appeals says of this invention:

“While the invention is not basic or primary, it is substantial and important, and is, therefore, entitled

“to a fair range of equivalents. Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405.”

The question before this court for review is one of fact. The special master’s finding that

“The modified Parker machines have all the elements
“and perform all the functions of the plaintiff’s patent,
“as defined by the Circuit Court of Appeals. The
“several rollers of the modified machines perform the
“same function in substantially the same manner as in
“the Strain invention and in the previous Parker
“device.”

Master’s Report, Tr. p. 286.

“The adjustment of the grade openings in all these
“machines, the Strain, the Parker patent, and the mod-
“ified Parker, is the adjustment of one grade opening
“independent of the effect upon the adjacent grade
“opening.”

Master’s Report, Tr. p. 290.

The master’s findings of fact will not be disturbed unless the court has before it all of the evidence taken by him, or at least all of the evidence which was before him relative to the particular finding or findings which are challenged.

McCourt v. Singers-Bigger, 145 Fed. 103-112;
Wheeler v. Abilene N. B. Bldg. Co., 159 Fed.
391-392;
Sheffield & B. Co. v. Gordon, 151 U. S. 285-293.

The master's findings of fact must be taken *prima facie* to be correct.

McNulty v. Wiesen, 158 Fed. 221.

Every reasonable presumption is in their favor, and they are not to be set aside or modified unless there clearly appears to have been error or mistake on his part.

Tilghman v. Proctor, 125 U. S. 149;

Callaghan v. Myers, 128 U. S. 666;

Crawford v. Neal, 144 U. S. 596;

Davis v. Schwartz, 155 U. S. 636-639;

Girard Ins. Co. v. Cooper, 162 U. S. 538;

Kimberly v. Arms, 129 U. S. 512;

Trust Co. v. Cooper, 162 U. S. 529;

Camden v. Stuart, 144 U. S. 104.

On matters of fact the master's findings have every reasonable presumption in their favor.

Cimiotti Unhairing Co. v. American Co., 158 Fed. 173;

Taintor v. Franklin Bank, 107 Fed. 825, 826.

The master's findings of fact where there is conflicting evidence have the force and effect of the verdict of a jury in a trial at common law.

Street Fed. Equity Practice, Sec. 1510, p. 912;

Dillingham v. Moran, 105 Fed. 933-936;

Missouri Pac. Co. v. T. & P. Co., 33 Fed. 803;

Central Co. v. Texas Co., 32 Fed. 448;

Murphy v. Southern R. R. Co., 99 Fed. 469;

Davis v. Schwartz, 155 U. S. 631;

Foster. Fed. Practice (4th Ed.), p. 997.

The question of infringement is “a question of fact
“for the jury to determine on all the evidence which
“the case might present.”

Royer v. Schultz Belting Co., 135 U. S. 319;
Transit Co. v. Cheatham Co., 194 Fed. 963.

In the case of

Wilson v. Barnum, 8 Howard 258,

the Supreme Court had before it the question of jurisdiction of the Supreme Court over a certificate of division in opinion between the judges of the Circuit Court of the United States for the Eastern District of Pennsylvania in a patent case. The certificate was attempted to be made under the Act of 1802. (2 Stat. at Large 159.) The question involved in the certificate was whether a certain device used by the defendant was an infringement of the Woodworth patent. The Supreme Court held that under such statute the only matters which could be so certified for the determination of the Supreme Court were matters of law and that the question of infringement was one of fact, and dismissed the certificate for want of jurisdiction. Mr. Chief Justice Taney delivered the opinion of the court and said:

“The question thus certified is *one of fact*, and
“has been discussed as such in the arguments of-
“fered on both sides. It is a question as to the
“substantial identity of the two machines.”

It is clear that the master's findings of fact in the more limited sense are not to be disturbed by the court. In this sense the master's findings of fact are those

which pertain to the mechanical construction of the modified or new type Parker machines, and these findings of fact are based upon the testimony of the defendant George D. Parker and the countervailing testimony of complainant and Arthur P. Knight, *and the inspection and observation* of these machines *by the special master*, both in actual use and under certain test conditions carried out or carried on by defendant Parker at the packing house of defendant Riverside Heights Orange Growers' Association in the presence of the parties to this suit, the special master, and the attorneys.

The special master's finding is that the only difference between these modified or new type Parker machines and the machines of the Parker patent, held to be an infringement by our Circuit Court of Appeals, resides solely in the roller side of the fruit runway. There is no possibility of contesting the correctness of this finding of fact, for the evidence shows that these are the same identical machines that were first built as machines of the Parker patent type and that the only changes that have been made in them have been in the roller side of the fruit runway, so that all of the elements of both claims one and ten of the patent in suit necessarily must be found in this new type or modified Parker machines, other than those elements which refer distinctly to the roller side of the runway. This fact eliminates the necessity of any consideration of any portion of the machine, other than the roller side of the runway, as expressed in claims one and ten, and narrows the question before the court down to the

question: Does the roller side of the runway in the new type or modified Parker machine perform the same or substantially the same function and in the same or substantially the same manner as the roller side of the runway in the Strain invention? If this question is answered in the affirmative infringement is determined.

In construing this Strain invention this court said:

“While the invention is not basic or primary, “it is substantial and important, and is, therefore, “entitled to a fair range of equivalents.”

The Supreme Court in its decision in the Paper Bag case (210 U. S. 405) has reviewed the entire question of scope of letters patent and the interpretation to be placed upon combination claims and has distinctly set forth the rule with regard to the doctrine of equivalents as applied to claims for combinations. This is the last word of the Supreme Court in this connection and it is one of the most important decisions on questions of patent law. This decision is cited and quoted in appellant's reply brief (case 2232), pages 39 to 42, heretofore filed with the court, and where it will be seen that the Supreme Court says:

“It is manifest, therefore, that it was not meant “to decide that only pioneer patents are entitled to “invoke the doctrine of equivalents, but that it “was decided that the range of equivalents de- “pends upon and varies with the degree of in- “vention.”

This rule then virtually means that a patent shall be so construed as to give the owner thereof the real

monopoly of the invention produced by the inventor, and that so broad a construction or interpretation is to be placed upon the claim or claims as is commensurate with his invention and will give to the owner of the patent that monopoly. It is thus seen that the necessity of determining an alleged invention to be a pioneer invention is obviated.

The law of this case is that the Robert Strain invention in issue is and was “substantial and important and “is therefore entitled to a fair range of equivalents.” This is *res adjudicata* between the parties and binding upon this court, and the only question for the court to determine is one of fact, to-wit: Has the alleged infringing device (the new or modified type of Parker machine) identically the same, or has it the equivalent, roller side of the fruit runway; or is the roller side of the runway totally distinct from the Robert Strain invention? If such roller side of such new type or modified Parker machine embodies Robert Strain’s inventive idea, then it is clear that it is an infringement. These observations bring us naturally to a consideration of what is meant by “equivalent” and the court is then thrown to a consideration of the “doctrine of equivalents” in patent law. This doctrine is not a new one, and is one of the best settled doctrines of patent law. An equivalent in patent law is

“A thing which performs the same function, “and performs that function in substantially the “same manner, as the thing of which it is alleged “to be an equivalent.”

Walker on Patents, 4th Ed., Sec. 354, p. 312.

“No substitution of an equivalent, for any ingredient of a combination covered by any claim of a patent, can avert a charge of infringement of that claim.”

Walker on Patents, 4th Ed , Sec. 350, page 308, and cases cited.

“Combination patents would generally be valueless in the absence of a right to equivalents, for few combinations now exist, or can hereafter be made, which do not contain at least one element, an efficient substitute for which could readily be suggested by any person skilled in the particular art.”

Walker on Patents, 4th Ed., Sec. 350, p. 308.

When it is said that an equivalent must perform substantially the same function and in substantially the same manner as the part for which it is substituted this must be taken with the qualification that the office of the equivalent so substituted must be the same. The identical mode of operation of the particular equivalent *per se* need not necessarily be identical or substantially the same. Each mechanical element necessarily will perform its particular function or contribute its own mode of operation, although it may make little or no difference in the general combination. As an example of this, a screw always performs its function in a substantially different manner or way from a lever and in substantially the same way as a wedge. Screws and wedges are equally inclined planes, while a lever is an entirely different elementary power. But screws and levers can be practically substituted for each other

in a larger number of machines than screws and wedges can be similarly substituted, and while a lever and a screw can be interchanged and still perform the same function with a result that is beneficially the same, they are said to perform the same function in substantially the same way.

Walker on Patents, 4th Ed., Sec. 353, p 310;
Gordon v. Warden, 150 U. S. 52.

Levers and springs are also used interchangeably in the arts, and constitute another example of equivalency.

Gould Coupler Co. v. Pratt, 70 Fed. 627.

In one case the Supreme Court decided that a confined volume of water in a cylinder worked by a pump and working a piston was the equivalent of a vibrating arm, toggle joint, and other mechanical devices, when used to transmit vibratory power.

Blake v. Robertson, 94 U. S. 732.

These equivalents and references show us that the test of equivalency is: does the combination of the patent and the combination alleged to infringe the patent do substantially the same work or perform substantially the same office and in substantially the same manner? In other words, is the inventive idea produced by the inventor copied? If it is, infringement is made out.

The two machines inspected by the master at the Riverside Heights Orange Growers' Association Packing House illustrate most forcibly that the modifica-

tions made by the defendant Parker in the machines manufactured and sold since the entry of the interlocutory decree, and since the service of the writ of injunction on defendants, and the changes made in prior machines, are simply a colorable modification of the machine of the Parker patent held by this court to infringe. The inquiry as to whether such modified machines infringe either claim one or claim ten of the Strain reissue patent is thereby much simplified. This is emphasized by reflecting that no change whatever has been made in the machine *except in one side of the grade-way*. All the other elements remain the same as in the so-called "Parker patent" construction held to be an infringement, and it is not necessary to pay any particular attention to any of such other elements, or to the relation of such other elements to each other. The issue of infringement submitted for the determination of the master was, therefore, extremely simple,—it may be stated thus:

Do the new or modified forms of machine contain the essence of the Robert Strain invention as defined and found by this court?

This court found that the Strain invention existed in "the combination with a traveling belt (common to "the Ish, Strain, and Parker machines) of a series of "independent rotating units arranged in longitudinal "succession parallel with the belt, each transversely adjustable."

The question of mechanical equivalency as usual enters into this question so submitted for the determination of the master and the fact to be found by the

master was: Do the several rollers of the modified Parker machine perform substantially the same function in substantially the same manner as in the Robert Strain invention or in the machine of the Parker patent? In answering this question it is to be borne in mind that the object of the Strain invention was to secure an individual control of each grading opening without affecting the next preceding or next succeeding grading opening. If this result is secured to an operative degree for fruit packing purposes in the modified forms of the Parker machines it is immaterial what effect such control or adjustment of the respective rollers may have on a portion thereof or a portion of an adjacent roller, *which does not in the operation of the machine form a part of a grading opening.*

In other words, the *sine qua non* of the Strain invention is the adjustment of the grading openings independent of the effect upon the adjacent grade openings. In the device of the Strain patent this is accomplished by a movement of the rollers toward or away from the traveling belt,—in other words, transversely of the longitudinal extension of such belt. In the Strain machine the grading opening is formed at the *front or approach end* of the roller and the *effective adjustment or control* of the grading opening formed is *by the adjustment at this end* of the roller. This is, of course, true of the rollers in both forms of the Parker modified machines and for the same purpose, and in practically identically the same manner.

In the modified form of the Parker machine the grading opening is formed at the initial or forward

end of the roller and between such portion of the roller and the longitudinally traveling conveying belt. Adjusting this end or portion of the roller transversely with respect to the belt (that is, toward or away from the belt) varies the grading opening and the size of fruit which can be discharged there through in the same manner in the device of the Strain reissue patent as in the device of the Parker patent. With the conical roller form of Parker grader the big end tapers the opening down or closes the opening between the roller and belt and prevents the rear end of the roller from forming an operative grading opening or space, being in this respect identical in function and effect with the overlapping guide arms of the machine of the Parker patent in that the rear end of each roller portion forms an idle or non-grading space in function and effect the same as the idle or non-grading spaces formed by the overlapping guide arms of the Parker machine. (It is doubtless unnecessary to point out in this connection that we are not in any manner concerned with the added function of the overlapping guide arms of the machine of the Parker patent, which added function was longitudinal adjustability lengthwise of the traveling belt. If the presence of such added function did not prevent the device of the Parker patent from infringing the elimination of such function of longitudinal extensibility cannot be material, as it simply brings the infringing device more closely to the device of the Strain patent.) As brought out in the testimony of complainant and Mr. Knight [Tr. pp. 140-148; Q. 123-126, p. 151; pp. 111-118], and

as demonstrated by observation of the machines at the Riverside Heights Orange Growers' Packing House, slight adjustment of this forward or initial end of a roller does not operatively affect the grading opening formed by the forward or initial end of the roller (and belt) next preceding or succeeding. In this connection it is to be borne in mind that the object of the individual adjustment is to increase slightly the size of the oranges of a given grade when they are not running quite large enough to give an even pack of a given size. In other words, as the difference in a "grading" size is only an eighth of an inch, this adjustment in any case could not reach as much as an eighth of an inch without an entire change of a grade or size, and ordinarily an adjustment of a half size or less than a sixteenth of an inch will bring the pack up even and uniform. This is brought out clearly in the testimony of Mr. Stebler. It is to be further noted that when the conical form of roller is used with the big end of the roller at the rear or away from the incoming fruit, the aperture or opening between the belt and each conical section of roller or each roller is diminishing in size as the fruit approaches the rear end of the roller. The sizing aperture is arranged at the forward end and it is clear, therefore, that the portion of the roller towards the rear forms no part of the grade opening.

In the second form of modified Parker machine the rollers are all of the same diameter, corresponding in this respect to the drawings of the Strain reissue patent. A filler stick or stationary arm (similar in function to the overlapping guide arms of the machine of

the Parker patent in that the portion covered by the stationary arms is idle or non-grading space) is used to block out any grading function for the rear end or rear half or three-fourths of the roller, and, like the conical roller form, the grading opening is formed solely at the front end of the roller and the rear portion of the roller performs no part in grading and does not in any sense form a part of the grading opening. The adjustment of this idle end of the roller does not operatively affect the grading opening formed by the forward or initial end of the roller and the belt. These two forms of Parker machines are equivalent in function and effect and are equivalent in mode of operation, function, and effect of the grade-way and members of the Strain reissue patent. The inventive idea of the Robert Strain patent is present in both these forms of Parker machine, and both of these forms of the Parker machine differ from the old Ish or California grader in the same distinct feature which formed the essence of the Strain invention as construed by the Circuit Court of Appeals.

When this case was argued before His Honor, Judge Olin Wellborn, the defendants contended that neither claim one nor claim ten of the patent in suit were infringed, because in the device of the Parker patent the rolls, taken in connection with the non-movable groove guide or belt, did not form a complete fruit runway, but were spaced apart by these overlapping guide arms, and that claims one and ten were limited to a roller side fruit runway. Complainant refers to this contention of defendants simply as illustrating how much

more closely the new modified forms of the Parker grader approach the Robert Strain conception of a grader than did the machine of the Parker patent as construed by Mr. Parker. In both of the types of modified form of Parker graders the entire runway is composed of the non-movable groove guide or belt on the one side and the series of end-to-end rollers on the other.

But defendants say:

“The new grader of the defendant is a backward “step in the art, being as it is the California grader.”

Logic teaches us that any conclusion based on a false premise must be erroneous. It was demonstrated at the Riverside Heights Orange Growers' Association's Packing House and carefully brought out in the testimony of Mr. Knight and Mr. Stebler, that individual and independent adjustment of each grading opening is secured in these new machines by adjustment of the given roller section toward (transversely of) the belt. It was proven by the record and found by this court that this independent or individual adjustment of the grade openings could not be secured in the device of the Ish patent or the California grader.

Inasmuch as these modified Parker or new style graders secure this independent or individual adjustment of the several grade openings they must be something other than,—more than, and different inherently from the California grader. This fact alone is sufficient to disprove defendants' statement that they are the California grader and proves that the very premise of defendants' argument of non-infringement is wrong.

Therefore, let us in our reasoning and in our consideration of these modified Parker graders start right.

Defendants' counsel makes the erroneous claim that the new type or modified Parker machines were similar to the old Ish or California grader, and that to sustain the finding of the master that these new type Parker machines were an infringement of the patent in suit was to enjoin the defendants from making or using the old California grader. This contention is utterly fallacious. There is not even a pretense on this record that the new type or modified Parker machines do not embody the inventive idea produced by Robert Strain, to-wit, the individual or independent control of each grading opening or discharge opening independent of the adjacent grade opening or discharge opening. There is no pretense in this case that such a result could be accomplished in the old Ish or California grader. The defendants may make, may sell, may use all the old Ish or California graders that they desire without any complaint on the part of this complainant. But they cannot and they may not embody in a machine the inventive idea of Robert Strain, shown to them for the first time by Robert Strain, and pretend that such new machine is an old Ish or California grader. The decision of this court has defined what the old Ish or California grader is, and it is clear that this independent control by the operator at his will of each grading opening, or sizing or discharge opening independent of the adjacent grading opening or discharge opening was a novelty which was the thing that stamped Robert Strain's machine as an in-

vention and its appropriation by the defendants is not the use by them of the old California or Ish grader, but the wrongful and unlawful appropriation of the patented invention.

The decision of this court is, and the proofs show, that Robert Strain's inventive idea was the individual adjustment of the several grade openings without affecting the adjacent grader openings. See complainant's opening and reply briefs in this court in case 2232.

Before the special master, referring to Robert Strain's invention, defendants contended that: "The "grader differed from the grader of the prior art by "the employment of *independent* rotating and independently transversely adjustable *units*." To this statement if defendants will add "power driven" before "rotating" we will have their contention as made before, and denied by, this court. Complainant contended that "roller" and "rotating" as used in the claims embraced or required only capability of moving on an axis. Defendants contended that mechanical means must be employed to cause such rotation and that the grader of the Parker patent did not infringe, as the rollers were not mechanically rotated. The distinction which defendants would now draw is that instead of each roller section being *independently driven* by mechanical means, the entire roller side is driven by a single means. Complainant's present contention is that the peculiar mounting and spacing of the several rollers forming the roller side of the fruit runway in the new type or modified forms of the Parker grader is the

full mechanical equivalent of the particular construction shown in Robert Strain's drawing, for the reason that the parts co-operate in substantially the same manner to produce substantially the same result, therefore, that Strain's inventive idea has been embodied in the modified machines in which, by adjusting a roller transversely toward or away from the belt the grade-opening formed at the approach or forward end of such roller and between such roller and the belt is controlled or varied without operatively affecting any adjacent grade opening. This cannot be accomplished in the California grader, but defendants say that the modified forms of Parker machines are the California grader. In one sense this is true, to-wit, by adding to such statement that they are the California grader *with Robert Strain's inventive idea added thereto and incorporated therein*,—that is, the individual adjustment of the grade openings without operatively affecting the adjacent grade openings. In this sense the statement is also true of the grader of the Robert Strain patent. This observation means nothing more than that the modified Parker graders are no more the California grader than is the Robert Strain grader; that both embody the Robert Strain invention and inventive idea and demonstrate conclusively that defendants are in error in their statement that the modified Parker machines are the California grader.

In connection with the statement just quoted from defendant's brief, reference is made by defendants to what is termed in such brief the California grader at the Rialto Packing House. Complainant understood

that evidence to this grader was admitted by the master solely as showing a machine which was open to the defendant Riverside Heights Orange Growers' Association to have used and to form a basis of comparison from which to draw a conclusion of the profits derived from the *use of the infringing machines*. It is clear that such evidence is incompetent and inadmissible in this case for any other purpose. It is a matter which has been closed prior to the reference to the master. The master may not receive additional evidence of the state of the prior art. But there is still another more cogent reason for not considering this particular Rialto grader, in the fact that the evidence shows it was not built or constructed until many years after the application for patent in suit and until after the actual issuance of the patent in suit. It is not a part of the "prior art" and there is not one scintilla of evidence in the remotest degree tending to prove that such a construction of grader was known or used prior to the Robert Strain invention. In fact, this Rialto machine is a machine which was built with full knowledge of Robert Strain's invention and of the devices embodying such Robert Strain invention. It is a modification of the Ish or California grader, made *not with the knowledge* of the art as it existed *prior* to Robert Strain's invention, but in view of and *after* full knowledge of the Robert Strain invention. No such machine ever existed prior to Robert Strain's invention.

It must be obvious to the court that two constructions of the roller side of the runway of one of these

fruit graders or sizers are equivalents of each other when they produce precisely the same result and secure that result in precisely the same manner. This is true of the device of the Robert Strain patent and of both of the new types of modified Parker grader. The sizing opening or discharge or grading opening is formed between the belt and the roller. The size of this opening is controllable by adjustment by the operator, and at his will, without affecting the adjacent sizing or grading opening. Not only is this true, but this control is secured in precisely the same manner. The mechanical adjustment control devices are slightly different. They are different only in degree and only in detail. The claims in suit do not call for, and are not limited to the details of such adjustment device. This is clear from the decision of this court. The two runways thus formed are fully equivalent and the roller side of each is the full equivalent of the other, and the manner of forming and adjusting the grade opening is the full equivalent of the other. In each the operative or effective grading opening is formed at the initial or forward end of the roller section and the rear end portion, or, to be more precise, the two-thirds of the roller away from the feed end performs no function in grading. This is true in both the machines of the Robert Strain patent and the modified Parker type of machines.

It is submitted that not only are the findings of the master supported by the evidence, but they are unquestionably correct.

An attempt has been made to criticise the findings of the master as set forth on page 287 of the Transcript of Record and the findings set forth on page 5 as inconsistent. This criticism, when the subject-matter of such findings is understood, is readily seen to be fallacious and incorrect. On page 3 the master finds that the modified machines are made up of a "series of independent rotating units." In this sense he is referring to the fact that they are independent in their adjustment, forming the effective grade opening or discharge opening. He is not referring to the fact that they rotate as one piece. On page 289 the master goes more into detail and says (last two lines page 289) that they "are not independently rotatable" and "are not independently adjustable with respect to each other." In this respect the master means that each roller section in the new type or modified type of Parker machine is not mechanically controlled independent of the adjacent roller section either as to rotation or as to adjustment, but neither of these is required to embrace or embody the Robert Strain invention. Robert Strain's invention was not independence in that mechanical means either as to rotation or adjustment. Robert Strain was not making an invention in either rotating devices or adjusting devices. He was an improver in a combination, and that combination was, as stated by our Circuit Court of Appeals, a "traveling belt (common to the Ish patent and Parker machines) and a series of independent rotating units arranged in longitudinal succession parallel with the belt, each transversely adjustable." As we have al-

ready stated, it makes no difference in the machine whether the rollers or roller sections rotate in synchronism or at different speeds and independently, and that which the Court of Appeals intended to emphasize by the term "independent" and by the term "transversely adjustable" in its opinion must necessarily refer to the independent adjustability of the operative portion of the machine, to-wit, the portion forming the grading opening or discharge opening. This portion is the forward or initial one-third of each roller section. Adjusting this end of such section varies the size of the orange discharged between the belt and the roller. This is true in the Robert Strain machine and true in the defendants' machines, and when reference is thus made to the defendants' machine we mean not simply the new or modified type of Parker grader, but also the device of the Parker patent and in the same sense.

Complainant's position before the court now is the same as it has always been in this case, but the defendants' contentions are confusing. The question really for the master to determine was, by adjustment within the control of the operator could the operator adjust each grade opening or discharge opening separately without affecting the adjacent discharge opening or grading opening? This is a question of fact, and the master has found that this can be accomplished, and accomplished in practical manner, in the new type or modified Parker machine. So finding this fact the question of infringement was determined and must be determined in favor of complainant's conten-

tion because this is the essence of the Strain invention. It is the inventive idea expressed by the Strain patent.

As said in *Eck v. Kutz*, 152 Fed. 758:

“The question is whether the inventive idea expressed in the patent has been appropriated; and, “if it has, infringement has been made out.”

As said in *Brown Bag Filling Machine Co. v. Drohen*, 140 Fed. 97-100:

“A device which is constructed on the same principle, which has the same mode of operation, and “which accomplishes the same result as another “by the same or by equivalent mechanical means, “is the same device, and a claim in a patent of one “such device claims and secures the other. Citing “*Machine Co. v. Murphy*, 97 U. S. 120-125.”

In *Ide v. Trorlicht Co.*, 115 Fed. 137, it is said:

“Mere changes in the form of a device, or of “some of the mechanical elements of a combination, will not avoid infringement, where the principle or mode of operation of the invention is “adopted. except in those rare cases in which the “form of the improvement, or of the element “changed is the distinguishing character of the invention.”

As said by Circuit Judge Nelson in *Blanchard v. Beers*, 2 Blatch. 416:

“The sure test, and one the jury should be “guided by in all cases of this kind, is whether or “not the defendant’s machine, whatever may be its “form or mechanical construction, has incorporated within it the principle, or the combination,

“or the novel ideas which constitute the improvement to be found in the plaintiff’s machine.”

As said by this court in *Norton v. Jensen*, 49 Fed. 859-866:

“It is well settled that a copy of the principle or mode of operation described in the prior patent is an infringement of it. If the patentee’s ideas are found in the construction and arrangement of the subsequent device, no matter what may be its form, shape, or appearance, the parties making or using it are deemed appropriators of the patented invention, and are infringers. An infringement takes place whenever a party avails himself of the invention of the patentee without such a variation as constitutes a new discovery.”

As said by Judge Nelson in *Tatham v. Le Roy*, 2 Blatch. 486:

“Formal changes are nothing—mere mechanical changes are nothing; all these may be made outside of the description to be found in the patent, and yet the machine, after it has been thus changed in its construction, is still the machine of the patentee, because it contains his invention, the fruits of his mind, and embodies the discovery which he has brought into existence and put into practical operation.”

In the case of *Detroit Copper Mining Co. v. Mine & Smelter Co.*, 215 Fed. 103, this court said:

“When the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention. *Winans v. Den-*

“mead, 15 Howard 330; Metallic Extraction Co. v. Brown, 104 Fed. 345, 43 C. C. A. 568; Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co. (C. C.), 132 Fed. 614.”

In *Los Angeles Art Organ Co. v. Aeolian Co.*, 143 Fed. 887, this court said:

“In passing upon the issue of infringement, the question to be determined is whether, under a variation of form or by the use of a thing which bears a different name, the defendant accomplished by his machine the same purpose or effect as that accomplished by the patentee, or whether there is a real change of structure or purpose. If the change introduced by the defendant constitutes a mechanical equivalent in reference to the means used by the patentee, and if, besides being an equivalent, it accomplishes something useful beyond the effect or purpose accomplished by the patentee, it will still be an infringement as respects what is covered by the patent, although the further advantage may be a patentable subject as an improvement on the former invention.”

See, also:

Machine Co. v. Murphy, 97 U. S. 120, 125, 24 L. Ed. 935;

Cantrell v. Wallick, 117 U. S. 689, 694, 695, 6 Sup. Ct. 970, 29 L. Ed. 1017.

In *Blandy v. Griffith*, 3 Fish. Pat. Cas. 609, Fed. Cas. No. 1529, the court said:

“As long as the root of the original conception remains in its completeness, the outgrowth—whatever shape it may take—belongs to him with whom the conception originated.”

In Walker on Patents, Sec. 376, the author said:

“On the other hand, a defendant’s machine may
“be better than that covered by the patent in suit;
“but if that superiority resulted from some addi-
“tion to the latter, it will have no tendency to
“avoid infringement.”

In Robinson on Patents, Sec. 30, the author said:

“To the patentee belongs not merely the ex-
“clusive right to what he has invented, but also the
“right to prevent others from using their own in-
“ventions, however valuable they may be, if they
“embrace a single one of his original ideas.”

In Curtiss on Patents, Sec. 320, the author, in dis-
cussing this question, said:

“The substantial identity, therefore, that is to
“be looked to, in cases of this kind, respects that
“which constitutes the essence of the invention,
“viz., the application of the principle. If the mode
“of carrying the same principle into effect adopted
“by the defendant, still shows only that the prin-
“ciple admits of the same application, in a variety
“of forms, or by a variety of apparatus, the jury
“will be authorized to treat such mode as a piracy
“of the original invention.”

See, also:

Kings Co. R. F. Co. v. U. S. Con. S. R. Co., 182
Fed. 59 (C. C. A. 9th Cir.).

“The object of the patent law is to secure to in-
“ventors a monopoly of what they have actually
“invented or discovered, and it ought not to be
“defeated by a too strict and technical adherence

“to the letter of the statute or by the application
“of artificial rules of interpretation.”

Topliff v. Topliff, 145 U. S. 156.

In *Hobbs v. Beach*, 180 U. S. 383, it is also said by the Supreme Court:

“If there be one central controlling purpose deducible from all these decisions, and many more that might be quoted, it is the steadfast determination of the court to protect and reward the man who has done something which has actually advanced the condition of mankind, something by which the work of the world is done better and more expeditiously than it was before.”

In this case defendants' entire argument is based upon the contention that what they are using is the Ish or California grader of the prior art, yet, as we have pointed out, defendants' modified or new type machines embody the Strain inventive idea. If defendants had manufactured the old California grader complainant would not be complaining. The Supreme Court of the United States has expressed this very aptly in

Diamond Rubber Co. v. Consolidated Rubber Co., 220 U. S. 444:

“It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done.”

Here the siren's song of the defendants is the California grader. They cannot praise that grader too greatly. Nevertheless they use the Strain grader. The

reason is apparent, they must use the Strain invention. The master was undoubtedly correct in his finding of fact that the new type or modified Parker grader infringed.

It was the duty of the special master to determine by the accounting "all of the infringing acts down to "the time of filing his report." "If the defendant has "made machines of changed construction he should re- "port as to them."

Hopkins on Patents, Sec. 413, p. 584.

Walker on Patents, 4th Ed., Sec. 742, p. 577, says:

"The extent of the defendant's infringement "must be determined by the master in order to "enable him to ascertain the amount of the profits "which the defendant derived from that infringe- "ment. Where the infringement was all alike, or "where the interlocutory decree specifies the par- "ticular doings of the defendant which are to be "accounted for as infringements, the only question "for the master to decide on this point is a ques- "tion of quantity. But where the interlocutory de- "cree merely directs the master to take and report "an account of the profits which the defendant de- "rived from infringing the complainant's patent, "and where the complainant claims that certain "doings of the defendant which were not proved "prior to the interlocutory decree, constitute such "an infringement, it becomes the duty of the mas- "ter to decide the question of infringement in- "volved."

Knox v. Quicksilver Mining Co., 6 Sawyer 436;
Ball Glove Fastening Co. v. Soxket Fastening
Co., 53 F. R. 245;

Fenton Metallic Co. v. Office Specialty Co., 12
App. D. C. 221;
Hoe v. Scott, 87 F. R. 220.

The case of Hoe v. Scott is one of the leading cases on this subject and the decision therein and the text just quoted of Walker on Patents is cited with approval by the Circuit Court of Appeals of the First Circuit in

L. S. Starrett Co. v. Brown & Sharpe Mfg. Co.,
208 Fed. 887-893.

“The question whether a defendant, after an
“interlocutory decree finding infringement of a
“patent, further infringed by the use of machines
“not before the court, is one that may properly be
“determined by the master on accounting.”

Brown Bag Filling Co. v. Drohen, 171 Fed. 438,
citing:

Wooster v. Thornton, 26 Fed. 274;

Westinghouse Co. v. Sangame Co., 128 Fed.
747;

Edison Co. v. Westinghouse Co., 54 Fed. 504.

See, also:

Thomas v. Electric Porcelain Co., 114 Fed. 407;

Hanifen v. Armitage, 117 Fed. 845-851;

Walker Patent Pivoted Bin Co. v. Miller, 146
Fed. 249-251;

Adams v. Keystone Mfg. Co., 41 Fed. 596.

The question whether the master should determine whether the modified Parker machines or new type

machines are infringements is not open for the master to determine. This matter has been determined by the decision of His Honor Judge Wellborn on the motion to enjoin the prosecution of the suits against the users. Judge Wellborn's decision will be found reported in

Stebler v. Riverside Heights Orange Growers' Association, 211 Fed. 985.

Judge Wellborn's first proposition being that

"The master has full authority to inquire into
"and find all acts of infringement by either party,
"and to award profits and damages for all such
"infringing acts. Robinson on Patents, § 1153 and
"note cited; Tathom v. Lowber, 4 Blatch. 86, 23
"Fed. Cases 722, No. 13765."

This decision was affirmed by this court. See 214 Fed. 550.

It would seem so elementary as not to require the citation of authorities,—that the master is bound by the decision of the Court of Appeals as to the scope of the claims and by the state of the art as found by such Court of Appeals. The validity of claims 1 and 10 and their scope is *res adjudicata*. It is the duty of the master to follow the interpretation given by the Circuit Court of Appeals, and certainly he cannot follow that interpretation if he receives additional evidence as to the state of the prior art. Further, matters which are not a part of the prior art could not have any bearing upon the scope of the claims of the patent in suit. In this case complainant insists that

no evidence is admissible before the master to show any different state of the prior art than that shown in the record upon which the interlocutory decree is based.

In

Murray v. Orr, 153 Fed. 369,

the Circuit Court of Appeals for the Seventh Circuit holds that the master cannot review the decree or inquire into the prior state of the art. In this opinion the court says:

“It was not open to defendants on the question
“of additional infringements to refer to the prior
“art to limit the scope of the invention to less
“than we have found it to be in determining the
“infringement of the Columbia ladder.”

In passing, therefore, the question as to the duty of the master to examine and determine this alleged subsequent infringement by the modified or new style Parker machine, complainant calls attention to the fact that the injunction secured by the defendant Parker enjoined the complainant from bringing any suit against any user or infringer of the Strain reissue patent. If, in accordance with Judge Wellborn's opinion, it is not the duty of the master to determine all infringing acts of the defendant Parker, complainant would be without any remedy whatever. Clearly if it were necessary to file a supplemental bill or an independent suit no injunction would have been issued to have prevented complainant's taking such action in such form as complainant should elect.

What materiality or relevancy the so-called new style California grader at the Rialto Packing House has upon the question of the scope of the claims under consideration is not apparent. How a construction which was not known and which had never been used prior to the date of the Robert Strain invention and which is and was not a part of the art prior to the Robert Strain invention can affect in any manner the question of infringement or the scope or interpretation to be given to the claims is not apparent. Clearly something that did not exist until after Robert Strain's invention cannot be held to be a part of the art prior to Robert Strain's invention and to have been known prior thereto. But in this connection it should be borne in mind that the individual control or adjustment of the grade openings without affecting operatively the adjacent grade opening or openings cannot be secured in this Rialto machine, and this is admitted and stipulated by the defendants and is borne out by an inspection of such machine, defendants apparently seek to try and determine the issues of equity suit A-92 with regard to a totally different construction and interrelation of parts of a grader and distributing system than that involved in the Parker modified machines or new type machines shown to the master. In such equity suit A-92 there is involved the adjusting trapdoor arrangement beneath the traveling belt, which arrangement was an infringement of the Thomas Strain patent number 775,015 and of the movable leaves by means of which independent adjustment was secured by raising or lowering the belt toward the roller, this being the

direct opposite of adjusting the roller toward the belt, and Mr. Knight is correct in stating that in this type of machine where the rollers are mounted, as in the Pasadena Orange Growers' Association machine, in sections upon brackets and rotated from one end, such series of rollers constitute in their operative effect a single roller for the length of the machine. It must be borne in mind that in that machine also this single roller thus formed was mounted at an inclination to the traveling belt. In other words, one end of this series of rolls was further away from the belt than the other end and in the same manner as specified in regard to the grading rod of the Thomas Strain patent. It is thus seen that the defendants seek to confuse rather than clarify the issues presented to the master. But there is another aspect of defendants' contention: If the series of rollers, each roller being smaller in diameter than the preceding roller, in the Rialto machine be considered as a single roller for the length of the machine, no provision is made therein for individual adjustment for the reason that each roller has the same diameter for its entire length and there are no arms or sticks blocking out the rear portion of the opening formed between such roller and the belt so that the effect of adjusting is diametrically the opposite to the effect of adjusting in either of the modified Parker machines. In the Rialto machine any adjustment affects at least two grade openings, and this is the meaning of the stipulation that an individual adjustment cannot be secured in the Rialto machine. In the form of modified Parker machine in which the rollers have

the same diameter from end to end it is necessary to provide the guide arms of the Parker patent to block out a portion of the opening between such roller and belt to form an idle or non-grading space in order to effect the individual adjustment without affecting the adjustment of the adjacent roller, thus showing the embodiment of the same feature in this form of modified Parker machine that was held to be an infringement by this court in its decision, 205 Fed. 735. In the Rialto machine no such guide arms were ever used. The fact that Mr. Stebler collected a royalty on account of this Rialto machine and licensed its use under the Ish patent is not determinative of any of the issues of this case. Mr. Stebler likewise collected many hundreds of dollars royalties from the manufacturers and users of machines like the Robert Strain machine and collected these royalties under such Ish patent and issued such licenses under said Ish patent. This license question is another interjection of defendants into this case which simply befogs the issues and does not present any matter which is determinative thereof.

In referring to the new type or modified form of Parker grader defendants say:

“It has, in common with the California grader, a “series of end to end connected rollers, all of said “rollers being driven in unison, and the ends of adjacent rollers are supported by a common adjustable “bearing support.”

This reference to the California grader is erroneous. There is not a word of testimony in the record to sup-

port it. The testimony in the record does show that the California grader was made up of two and possibly three sections of roller, all connected together, to be driven in unison, the abutting sections supported by a common adjustable bearing support, but this statement disregards the vital essence of the California grader or Ish patent construction as found by this court and as shown by the testimony, to-wit, that never prior to Robert Strain's invention had a grader been made in which the roller side of the runway was formed of roller sections, each roller section having a single diameter its whole length. On the contrary, each of the sections composing the roller side of the runway in the California grader used prior to the Robert Strain invention were provided with at least two steps, so that the Rialto machine does not correspond with any of the California graders of the art prior to Robert Strain's invention. This is the finding of this circuit on the evidence adduced which is determinative of these issues and *res adjudicata* between the parties. Of course, if the statement just quoted from defendants is intended to refer to the Rialto machine (which defendants call a California grader), then the statement just quoted is true, but we have nothing whatever to do with such Rialto machine. It is not a part of the prior art and it cannot be considered for the purpose of limiting the claims or the scope of the claims. Such questions are *res adjudicata* between the parties, and even if not *res adjudicata*, the features referred to in this statement might be common in five hundred different graders. It is, however, begging the issue to

compare two devices, one of which will perform a given function in a given manner and the other which cannot perform such function. The Parker modified machines as exhibited to the master have the individual control of each grade opening without operatively affecting the adjacent grade opening. Defendants concede that this Rialto machine does not have this feature. This court has found that no California grader had this feature, therefore, the comparison made by defendants is immaterial.

Complainant's question is: Why do defendants compare their modified Parker or new type machine with a construction which was not in existence or known until years after the Robert Strain invention, instead of comparing the same with the California grader as it was proven to have existed, to have been manufactured, and to have been used prior to Robert Strain's invention?

Nothing was ever more significant in a law suit. The action of defendants is an admission that the prior art as determined by this court, and as proven in the record upon which the interlocutory decree under which the master acted was based, does not show anything comparable with the modified Parker machines or new type graders.

If it were proper to compare the Rialto machine (erroneously called by defendants the California grader) with either of the modified Parker graders, it is seen that with such Rialto machine the adjustment of any of the supporting means affects the position of two adjacent rollers while the adjustment of two com-

panion adjustable means or bearing supports varies the position of three of the rollers, and thus coincidentally changes two, or in the latter case three, different grades. In this Rialto machine there are no devices used corresponding to the guide arms or filler sticks of the grader of the Parker patent which are necessary in the cylindrical roller type of modified Parker machine in order to secure the individual adjustment of the grade openings without operatively affecting the adjacent grade opening or openings. The portion of the roll in this particular type of Parker machine thus blocked out by such guide arm or filler stick is a mere idle or non-grading space in the same relation as in the case of the overlapping guide arms or filler sticks of the device of the Parker patent and differs radically in function and effect from anything in the Rialto machine.

Defendants have made many references to the fact that in the modified Parker machines the several rollers are not "independently rotatable with respect to each other." These references are not understood. This court, in construing the claims in issue, has not held that they were limited to being independently rotatable or independently rotated, and there is no difference, so far as performing their functions as a part of the grade-way or in forming the grade openings, whether they are indepently or coincidentally rotatable or rotated. This feature does not enter into the case in any manner.

The following facts have been established by the decision of this court, are *res adjudicata* between the parties, and were not subject to review by the master:

1. The “Ish” or “California” grader or sizer did not contain such an arrangement of elements as enabled the independent or individual control or adjustment of a given grade-opening or discharge opening without coincidentally changing an adjacent grade or discharge opening.

2. That Robert Strain was the first to conceive the individual or independent control or adjustment of respective grade openings or sizing apertures without affecting adjacent grade openings or apertures. This was his “inventive idea” (*Eck v. Kutz, supra*), and this is what his patent covers.

3. That no “Ish” or “California” grader had ever been known, made, or used (*prior to Robert Strain’s invention*) with a separate roller or roller section for each grade. That by using an individual or separate roller for each grade a decided and distinctive result is secured. This is a result and a mode of operation not securable in any “Ish” or “California” grader known, made, or used prior to Robert Strain’s invention. By this individual adjustment or control of the grade openings or grading apertures is rendered possible that the “Rialto” grader (inspected by the master) does not embody the “Ish” or “California” construction of the art prior to Robert Strain’s invention.

4. That Robert Strain’s invention was “substantial “and important” and not a mere improvement in detail of mechanisms.

5. That the manner of rotation of the separate or individual or independent rollers or roller sections is immaterial. They may be power driven or not. Either will embody the Robert Strain invention.

6. That the “independence” of the rollers or roller sections is an “independence” as regards the control or adjustment of the apertures through which the fruit is discharged and thereby separated according to size. Therefore, the *sine qua non* of such “independence” is solely the movement of each roller or roller section toward or away from the belt in such manner as to effectively control the size of fruit which will pass out at a given roller or roller section. Only so much of the roller is involved in this as forms part of the actual discharge portion. Any slight movement not effecting a change in the size of fruit discharged at an adjacent discharge portion or aperture does not affect the result nor the idea of means nor change the real character of the machine.

7. That the new style or modified Parker graders are not “Ish” or “California” graders, for the reason that they embody the separate, individual, and independent control of the discharge apertures or grade openings by adjustment of the respective rollers or roller sections without affecting the size of fruit discharged by an adjacent grade opening or aperture.

8. That the prohibition (by the injunction in this case) of the further making, use, or sale of the so-called new type or modified Parker graders does not interfere with the right of any one to make, use, or sell the “Ish” or “California” grader (in which no indi-

vidual or independent adjustment of each grade discharge is possible without affecting an adjoining grade discharge).

The master found that the new type or modified Parker graders were a closer imitation of the particular embodiment of the Strain invention than the Parker patent type. This finding is correct. The entire wall of the runway in the new type is of rollers. This conforms to the exact letter of the claims, while the overlapping guide arms of the Parker patent type was a departure from the letter of Strain's claims.

The appellants' contention that the master erred in considering the new or modified types of graders for the reason that

“the differences are such as to create a new machine, one constructed of elements working on a different principle of operation from the patented (Parker) device” (Appellants' Brief, p. 28),

has no foundation in fact. Nor does it ring true with appellant's contention that such graders are nothing more than the old “California” graders. Yet it is a “question of fact,” which must be determined before it can be held (even under defendants' asserted rule of law) that the master erred in hearing and determining such question of fact. In other words, the rule of which defendants assert requires a finding of fact before the master considers the evidence.

The admitted history and construction of the very modified machines inspected by the master shows the correctness of the master's proceeding. It was proven

by the testimony of complainant and defendants that the very machines against which *this* court ordered an injunction had been only *colorably modified* in an attempt to avoid such injunction. It was proven by uncontradicted testimony that no changes whatever had been made in such machines *except* in the roller side of the fruit runway, and that these changes consisted solely in substituting for the overlapping guide arms, roll-carrying brackets and rolls, a series of end-to-end rolls, the ends of the rolls closely abutting, together with adjusting brackets, etc. No other changes were made. The master held these changes were merely colorable. That in fact the modified machines more clearly infringed the terms of the claims than did the Parker patent type of machines. The master *followed* the interpretation placed on the claims and on the Strain invention by this court. He did not give the patent "an enlarged construction." On the contrary, he determined the fact to be that the modification made in the roller side of the fruit runway brought the machines more closely within and to the Strain invention and to the particular embodiment thereof shown in the patent in suit than was the Parker patent construction.

This court must first reverse the master's finding of fact,—based upon his seeing the witnesses, observing their manner, and hearing the oral testimony of the witnesses, plus *his own personal inspection and comparisons* of the machines,—before this court can accept defendants' statement that "the differences are such as to create a new machine, one constructed of elements working on a different principle of operation from the

patented (Parker) device”—and apply the rule contended for by defendants.

Clearly the procedure by the master was according to the cardinal principles of equity jurisprudence. Equity intervenes to prevent a multiplicity of suits. The master's procedure avoided additional suits. The master's procedure prevented an evasion of the decree of this court in this suit by a mere colorable change of the very machines enjoined. The Honorable Judge of the District Court agreed with the master and considered the making and sale of the modified graders a wilful infringement. On account of such further infringement in the very teeth of and in contempt of the writ of injunction, His Honor Judge Bledsoe inflicted punitive damages in the sum of \$2,340.20 under sections 4919 and 4921 R. S. U. S. because these modified machines were *mere colorable evasions*.

In appellants' brief opposite page 29 there has been inserted a set of illustrations or drawings, six in number. With regard to these it is first to be noted that none of them are in evidence.

Fig. 1 of these drawings might be taken as a diagrammatic view of the particular construction described and shown in the Ish patent #458,422 considered by this court in 205 Fed. 735, although this drawing is not sufficient for a clear understanding of that device.

Fig. 2 is misleading. There is no evidence that such a machine as this was constructed *prior* to the Robert Strain invention. The modified Ish or California grader as it existed prior to the Robert Strain inven-

tion was before the court on the first appeal and considered by this court in its decision, 205 Fed. 735, and there was before the court a model illustrating such construction. The construction differed from the Ish patent as shown in the record on the first appeal and discussed in the brief. It was admitted by all the witnesses in behalf of both the parties that none of these Ish or California graders were so constructed that the operator at will could control each grade opening separately without affecting an adjacent grade opening, and this was the finding of this court.

Fig. 3 of these drawings is a showing of an installation which is not before the court. It is complainants' position that in this case all questions of the novelty of the Strain invention were fully considered and passed upon and rendered *res adjudicata* between the parties by the decision of this court in 205 Fed. 735, and it would have been error on the part of the master to have permitted the introduction of any further testimony for the purpose of limiting the scope of the claims of the patent in suit or for the purpose of putting a different interpretation thereon than the interpretation placed thereon by this court in its decision, 205 Fed. 735, under which the special master was acting. It follows, therefore, that if what is now asserted to have been this Fig. 3, or "Jameson" California sizer, differs in any respect from the showing made on behalf of the defendant when this case was heard upon the merits of the Strain patent and invention and its novelty and scope determined, then such evidence cannot properly

be brought before this court or considered by either the master, the District Court, or this court.

There comes a time in litigation when the parties are foreclosed from introducing evidence upon their defense, and it is submitted that in this litigation that time was reached when the case was heard at final hearing. The Rialto machine or the Jameson machine could only be used by the special master *as a means of comparison in determining the profits* derived by the defendant Riverside Heights Orange Growers' Association from the use of the Strain invention as having advantages over any machine or machines which were free to be used by such association. This question has been entirely eliminated from the case, as complainant has elected to abandon any claim of profits against the Riverside Heights Orange Growers' Association and asked for damages only as against that defendant.

The special master was correct in sustaining complainants' objections to the offer of further proof in regard to this Jameson machine. It was not competent for the defendant to offer further evidence of the state of the prior art for the purpose either of anticipating the Strain invention or limiting the scope thereof. (*Murray v. Orr*, 153 Fed. 369.) These matters were *res adjudicata*.

The attempt by the defendants to offer further evidence before the master in regard to the Rialto or Jameson machines upon either the question of infringement or the scope of the Strain invention was merely cumulative. The entire history of the Ish or California graders or sizers had been thoroughly thrashed

out in the final hearing of this case and fully determined by this court in its decision upon the first appeal. The Jameson machine was pleaded in defendants' answer as an anticipation and proofs were taken in regard thereto. These proofs were considered by this court upon the first appeal. The attempt of defendants to offer further evidence in regard thereto was merely an attempt to offer cumulative evidence and there had been no order made reopening the case for further consideration of any of the issues which had been determined.

The testimony of Frank Proud [Trans. Record on first appeal, page 275] shows that this "Jameson" grader was not rebuilt by Mr. Proud until after Mr. Strain's invention, and has been fully considered by this court.

It is submitted, therefore, that the new evidence attempted to be offered before the master in regard to either the Rialto or the Jameson machine must be excluded from consideration.

The deposition of Edgar R. Downs on behalf of defendants shows that this Rialto machine was not built until 1905, four years after the Strain invention by Robert Strain [Transcript of Record, pp. 106-109].

The parties stipulated that the manner of supporting and adjusting the roller side of the runway of this Rialto grader was not such as to permit in any manner the individual adjustment of separate grade openings formed by the roller surface and the belt. This is admitted on page 54 of appellant's brief. In this respect the machine corresponded to the California grader.

[Tr. p. 109; see also testimony of Mr. Knight and Mr. Stebler.]

In this connection it must be borne in mind that the new Parker sizers or modified graders held by the master to infringe, are so constructed as to embody this inventive idea produced by Robert Strain of so constructing the roller side of the runway that each grade opening may be adjusted without affecting the adjacent grade opening. Undoubtedly this Rialto machine infringed the Ish patent, and the licensing in 1905 of the Rialto machine under the Ish patent owned by complainant raises no question of such particular construction being known in 1901, the date when Robert Strain made the invention covered by the patent in suit. Thus again we find that the Rialto machine could have been material only for use in a comparison as to the profits or advantages derived by the defendant Riverside Heights Orange Growers' Association from the use of the infringing machines over the use of the machines which were open and free to it to use. That question, however, has been eliminated from the case, and the Rialto machine is therefore eliminated from the case.

However, with this "Jameson" construction no such result can be secured as is secured by the device of the Strain patent in suit, the Parker type of grader, or the modified Parker graders. It is impossible to secure any individual adjustment or control by the operator of the individual grade openings without affecting the adjacent grade or discharge opening in this "Jameson" machine.

Each of the statements of appellants' brief referring to these various machines or drawings inserted opposite page 29 of appellants' brief, i. e., like the statement on page 31 referring to the device of Figure 2 that—

“The roller sections were mounted in bearing
“brackets E, so that the roller sections could be
“adjusted toward and from the fixed member A
“of the fruit runway to vary the distance there
“between, so as to regulate the grade outlets of
“the apertures for different size fruit”

must be carefully scrutinized. The statement is true, but it is only half the truth. With the old Ish patented construction the graduated roller could be adjusted toward or away from the belt, but such adjustment effected more than one grade opening or aperture at a time, and this is true of the devices illustrated in Figs. 1, 2, 3 and 4 of the drawings of appellants' brief opposite page 29, and this essential differentiation is not referred to, but, on the contrary, ignored in appellants' discussion of the drawings. These matters have been fully determined by this court on the first appeal.

In appellants' brief the defendants have misconstrued the Strain invention. They have misconstrued the Strain reissue patent in suit. They are again insisting upon the same interpretation which they urged in this court, and which was repudiated by this court, upon the first appeal. They also misconstrue the decision of this court.

This court distinctly found that the Strain invention was not limited as claimed on pages 36 and 37 of appellant's brief. This court found that—

“While the invention is not basic or primary, it “is substantial and important, and is therefore “entitled to a fair range of equivalents.” (205 Fed. 740.)

“The invention, we think, was an *important and “distinct advance* in the art.” (205 Fed. 738.)

Defendants’ argument on pages 36 and 37 of appellants’ brief again turns on words and terms. It ignores the inventive idea produced by Robert Strain and ignores the true rule of interpretation. This portion of said brief is fully answered in appellants’ briefs on the first appeal (case 2232).

As said by the Supreme Court in *Bates v. Coe* (98 U. S. 31):

“In determining about similarities and differences, courts of justice are not governed merely “by the names of things, but they look at the machines and their devices in the light of what they “do or what office or function they perform, and “how they perform it, and find that a thing is substantially the same as another, if it performs substantially the same function or office in substantially the same way to obtain substantially the “same result; and that devices are substantially “different when they perform different duties in a “substantially different way, or produce substantially a different result. *Cahoon v. Ring*, 1 Cliff. “620.”

As said by this court in *Los Angeles Art Organ Co. v. Aeolian Co.* (143 Fed. 880, 887):

“If the change introduced by the defendant constitutes a mechanical equivalent in reference to

“the means used by the patentee, and if, besides
“being an equivalent, it accomplishes something
“useful beyond the effect or purpose accomplished
“by the patentee, it will be an infringement as re-
“spects what is covered by the patent, although the
“further advantage may be a patentable subject
“as an improvement on the former invention.”

“The range of equivalence depends upon and
“varies with the degree of invention.” Citation
Paper Bag Co. case, 210 U. S. 405.

Defendants' argument is that the Strain invention is limited to details of construction and that the claims must receive a narrow literal construction. This is the same error into which defendants fell in their contentions before this court upon the first appeal, and this contention was rejected by this court as seen by the first paragraph on page 740 of the court's opinion in 205 Federal Reporter.

As urged by the complainant upon the first appeal, the question before the master and now before this court is “*whether the inventive idea* expressed in the patent has been appropriated, and if it has, infringement has been made out.” (Eck v. Kutz, 152 Fed. 758.)

On page 40 of appellants' brief two quotations have been made from complainant's brief upon the first appeal to this court (case 22-32). The observations thus quoted refer to the *preferred* embodiment of the invention as disclosed by Mr. Strain in the drawings of the patent. It is well known that a given inventive idea may be embodied in various forms, and there was nothing in either of these statements, or in any state-

ment of the opinion of this court upon the first appeal that intended to even intimate that the Strain invention was limited to absolute independence of the rollers with respect to each other. A fair reading of complainant's briefs on the first appeal and the court's opinion will clearly demonstrate this. The "independence" referred to by this court on page 739 of its opinion is an independence in the operative adjustment of each grade opening without effecting the adjoining grade opening. This was the nub or kernel of Robert Strain's invention as set forth and claimed in complainant's briefs on the first appeal and as interpreted by the court.

On page 33 of appellants' brief we find a most amazing statement. It must be attributable to carelessness, for it certainly cannot be made with the intention of deliberately misleading the court. Yet this statement emphasizes the care which must be exercised to avoid being misled by the cuts or drawings inserted opposite page 39. We quote from page 33:

"He (*Parker*) proceeded to place on the market "a fruit sizer constructed in all essentials like the "device of the Rialto grader."

Yet the writer of that brief has confessed or stipulated on the record and in the presence of the special master that the Rialto machine cannot be adjusted to regulate one grade opening without simultaneously and coincidentally effecting an adjacent grade opening!—The very thing required in and produced by the grader construction and the interrelation of elements which Mr. Parker proceeded to make and place on the market.

Such statements in a brief naturally teach that all the statements and arguments therein contained are to be read with caution and, we might possibly say, *with suspicion*.

This same caution must be exercised in reading and analyzing the alleged comparison of the new or modified Parker graders with the so-called Jameson grader, *if that grader were before the court*.

If this court will refer to the brief filed in this court on behalf of these defendants on the first appeal in this case, this same error will be found, i. e., defendants ignore in all their comparison the question of individual or independent adjustment of the grade openings without affecting adjacent grade openings. This was Robert Strain's invention as found by this court. It is admitted it is wanting in the Ish or California graders, including the so-called Rialto and Jameson graders. In view of this lack of such "important invention" in such California graders and the presence thereof (which cannot be denied) in the new or modified Parker graders, *how exceeding strange* sounds this extract from appellants' brief, page 35:

"We therefore state, without hesitation, *that the "Parker new sizer is a California sizer of the prior "art, and therefore it follows that the Parker new "sizer placed on the market by the appellant Par- "ker since the rendition of the interlocutory de- "cree in this case, is not and cannot be held to be "an infringement of the sizer of the Strain reissue "letters patent."*

Clearly this statement is erroneous. But it serves excellently to bring out clearly defendants' inconsistency.

"The prior art was open to the rubber company. That 'art was crowded,' it says, 'with numerous 'prototypes and predecessors' of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. And yet the rubber company uses the Grant tire. *It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done.*"

Diamond Rubber Co. case, 220 Fed. 444.

Appellants' brief devotes several pages to the defendants' old argument in regard to the preferred form of the Robert Strain invention, as shown in the drawings of the patent, embodying means for positively rotating each roller section separately and independently. This argument of this appeal has had its dress cut in the latest style to fit appellants' argument to 1916 conditions of this law suit, but it is the same old fallacious argument. Means for driving the rolls or roller sections form no part of the Strain invention in its broad aspect. On the first appeal defendants claimed non-infringement *because the rolls of the Parker patent grader were not positively rotated by any mechanical means.* This court correctly held the means for rotating the rolls had naught to do with the combinations of claims 1 and 10. This matter was most fully discussed in the briefs on the first appeal. It was shown to the satisfaction of this court that provision

must be made so that no pinch of the fruit would occur as it was carried along by the belt. Naturally if the roller be positively and mechanically rotated upward away from the belt that gave the most certain insurance against pinching the orange between belt and roller. But the evidence demonstrated that the roller would automatically rotate upward and that mechanical driving means were not absolutely essential. Appellants' argument, on this appeal, with respect to the means for rotating the roller side of the runway is an attempt to limit the invention to a narrow, literal construction of the specific forms of elements shown in the drawings, which in law only illustrate *the preferred form*. (R. S. U. S. 4888.) This court held that the invention and patent were not to be so limited. In connection with this contention defendants quote, on page 39 of appellants' brief, the answers of complainant to X. Q. 139 and X. Q. 57, but apply these to a different subject by erroneous application. Complainant testified that *in all* the California graders, prior to Robert Strain's invention, the roller side was constructed in sections coupled together in such manner as to form a continuous roller *so that no independent or individual adjustment of one grade opening could be had without affecting an adjacent grade opening*.

Nowhere has complainant testified that the independent *mechanical* rotation of the rollers was essential, or that driving or rotating each roll separately was the distinguishing feature between the Robert Strain invention and the prior "California" grader.

We quote from page 28 of appellants' opening brief on the first appeal as follows:

"A slight variation existing between defendants' machines and the machine shown and described in the patent in suit resides in the omission of positive driving means for rotating the individual rollers. Mr. Strain has shown his rollers positively driven by belts, and such positively driving the rolls has been made an element of all the claims of the reissue patent except claims one (1) and ten (10), the only ones in controversy in this litigation.

"To limit either claim 1 or claim 10 to the means for positively rotating the rollers is to make such claims practically identical and of the same force, effect and scope as other claims in the reissue patent, and the fact that no mention is made in either of these claims shows the intention not to limit them to such driving or rotating means. This is particularly emphasized by the inclusion of such means in the other claims wherein they are definitely called for by the term 'means to revolve each of said rollers, etc.,' in claim 3, and 'means for driving the rolls,' claims 4, 5, 6, 7, 8 and 9. In fact, the reason for not including others of the claims as infringed by defendants' machines is solely because of the limitation thereof to such 'means for driving the rolls.'

"The defendants' machines embody and utilize rotating rollers to form the grading openings. Rotation of these rollers is caused by the oranges being propelled along by the belt, the position of the belt being slight under the horizontal axis of the roller,

“the fruit is carried along by the belt as an upward movement against the surface of the roller, causing it to revolve.

“Removal of the driving belts of the Strain machine demonstrates that the action is the same, the rollers rotating under the advancing action of the fruit in the same manner and direction as where the driving belts are used, the difference being merely one of degree. The testimony of the witnesses on this point is definite and certain.”

Pages 29-41 of said brief contain extracts of the testimony concerning this feature, demonstrating that this court held that the presence or absence of positive or mechanical means for rotating the rollers was not material to the Strain invention or to the claims in suit.

Appellants' whole argument may be summed up by the rules of interpretation cited on page 57 of their brief. These are to the effect that *“the invention must be restricted to the forms shown and described by the patentee”* and *“the claim must be strictly construed.”* It is thus apparent that appellants *concede* that in order to prevail upon this appeal they must insist that this court reopen its decision and reverse its finding that the Robert Strain invention *“was an important and distinct advance in the art”* (page 738) and that *“the language of the claims is not, as argued by the defendants, to receive a narrow, literal construction. While the invention is not basic or primary, it is substantial and important, and is, therefore, entitled to a fair range of equivalents.”* (Page 740.)

It was the duty of the master to consider the Strain invention and to apply this interpretation so made by this court. The master did not err by following the decision of this court. That decision was binding upon him and upon the District Court. It is the law of the case.

On pages 44 to 48 of appellants' brief references are made to and alleged quotations from affidavits alleged to have been made by complainant by Mr. Knight and by one Thomas Strain in other litigation. We desire to call the attention of the court to the fact that neither of these affidavits are a part of the record in this case or before the court. The alleged affidavits of complainant Stebler and of Thomas Strain were never in any manner made a part of the record before the special master.

By referring to the printed transcript on page 122 it will be found that defendants offered in evidence the alleged affidavit of Mr. Knight, but it has not been made a part of the transcript on appeal, and is not before the court. It will be found, however, that no affidavit by Mr. Stebler was ever produced before the master and that no such affidavit is a part of the transcript before this court.

The alleged quotation on page 47 of appellant's brief from an alleged affidavit of Thomas Strain is entirely *dehors* the record. It was never referred to before the master or before the District Court, and would have been incompetent and inadmissible in any event.

The alleged affidavits of Mr. Stebler and Mr. Knight could only be used in impeachment, and Thomas Strain

was not called as a witness in this case. It must be apparent, therefore, that the alleged affidavit of Thomas Strain could not be used for any purpose, and the alleged quotation therefrom on page 47 of appellants' brief cannot be considered.

The same is true of the alleged quotation from an alleged affidavit by Thomas Strain, Jr. This is not before the court,—it was not before the master,—it was not before the District Court. Thomas Strain, Jr., was not called as a witness in behalf of either of the parties. These *ex parte* affidavits certainly are not competent testimony for any purpose.

The statement on page 45 of appellants' brief that the affidavit of Mr. Knight was "for the purpose of identifying defendants' new sizer or grader with the sizer or grader of the said Thomas Strain patent No. 775,015" is misleading. The testimony of Mr. Knight before the special master shows that the defendant Parker commenced the manufacture and installation for the Pasadena Orange Growers' Association of certain graders. That as first erected and installed these graders were provided with means for raising the traveling belt toward the roller to thus adjust the grade opening, such means consisting of hinged leaves or trapdoors which were mounted upon adjusting screws so that the hinged leaves or trapdoors might be pushed against the traveling belt, raising the surface it travels over and correspondingly raising the belt toward the roller.

When Mr. Parker had this installation about completed suit was brought by Mr. Stebler for infringe-

ment of this Thomas Strain patent. Upon this suit being filed and motion for temporary injunction made and an order to show cause issued, the defendant Parker changed this construction and totally eliminated from the Pasadena machines this trapdoor or hinged leaf construction.

It was with reference to the machines as constructed with this hinged leaf or trapdoor adjustment that Mr. Knight made the affidavit referred to.

Naturally any attempt to apply the *ex parte* affidavit testimony of Mr. Knight when comparing an entirely different construction and interrelation of mechanism would not apply to the new or modified forms of Parker machines, and this is thoroughly explained in the testimony and was completely understood and correctly applied by the master. Mr. Knight's affidavit did not in any manner impeach his testimony before the master, and any use of such affidavit could only be for the purpose of impeachment.

Appellants' brief, page 48, states that defendant Parker testified that the modified machines of the Riverside Orange Growers' Association were the same in all respects as the machine which was built for the Pasadena Orange Growers' Association. Unfortunately, this is only a part of Mr. Parker's testimony, and it is only a part of the truth when this statement is attempted to be read as a statement that the modified machines as held by the master to infringe the Robert Strain reissue patent were the same as the Pasadena Association machines *at the time* of the making of the affidavits by Mr. Stebler and Mr. Knight. The testi-

mony of Mr Parker on cross-examination shows that any attempt by him to claim that the Pasadena machines had not been changed after suit A92 was brought against him, was defeated. Mr. Parker's testimony [Transcript of record, pages 171-172, cross-examination] shows that the entire theory of adjustment of the grade openings was changed after suit A92 was brought and the motion for temporary injunction made and order to show cause issued. *After this*, the Pasadena machines were so changed as to infringe the Robert Strain reissue patent now before this court.

A great insistence is found in appellants' brief that the so-called Rialto grader is the same as the California grader and is in fact a California grader. On pages 54 and 55 are found quotations from the testimony of Mr. Knight to this effect. But appellants apparently lose sight of the fact that even if it be admitted that the Rialto grader was a California grader it does not help appellants. Neither the California grader nor the Rialto grader embodies the feature of separate control or adjustment of each grade opening without affecting the adjacent grade-opening. On the other hand the new or modified Parker graders do embody this important invention and it has been judicially and finally determined by this court that this was the invention of Robert Strain and the subject of the patent in suit. It is clear, then, that every comparison which fails to take this inventive idea into consideration serves solely to befog the issue.

The difficulty confronting appellants is that this inventive idea is totally lacking in the prior art.

All of appellants' argument relative to the rolls of the preferred form of the Strain patent being "separately" mounted falls,—for the reason that such detail of construction is not necessary to the embodiment of the inventive idea in a practical machine and the claims in suit are not limited to such detail. This is true of each and every of the other limitations to details, insisted upon by appellants.

All of appellants' argument is answered by one question,—Why, if the California grader was so efficient and so satisfactory, did appellants find it necessary to deviate therefrom and to employ in the new or modified Parker machines this inventive idea of Robert Strain's,—the individual adjustment of the grade-openings without affecting adjacent grade-openings?

Appellants' Fifth Assignment of Error.

Clearly the District Court did not abuse its discretion in allowing complainant double damages for the manufacture and sale of the twenty modified Parker graders, manufactured and sold in open defiance of the injunction. Bearing in mind that defendant Parker, as the record clearly shows, is still in possession of a large profit from his wrongdoing and that complainant is a great loser by reason of the infringement and has been caused to spend thousands of dollars to protect his rights under the patent in suit and to recover a part of his loss occasioned by the wrongful acts of defendant Parker,—bearing in mind that the defendant Parker has been exceedingly and stubbornly litigious and has fought every possible contention to the last ditch,

—the District Court was clearly justified in penalizing Mr. Parker. The sum of \$2340.20 is a small compensation for the many thousands of dollars loss in expense of litigation, which cannot be taxed as costs or disbursements. This court would be justified in increasing this allowance under the circumstances of this case. See

48 C. C. A. 470;

Consolidated Co. v. Diamond Co., 226 Fed. 455.

In this case just cited the court increased the damages by the sum of \$50,000. The court took into cognizance the fact that the defendant had,—like defendant Parker here,—sought by every device to infringe the patent with impunity. Here defendants sought to avoid the writ of injunction ordered by this court by a merely colorable alteration of the very machines against which this court had ordered an injunction. They still praise the prior art, but they must and do embody the Strain inventive idea in their machines to filch complainant's business from him.

The rule is that the awarding of treble damages for infringement under R. S. U. S. 4919, 4921 (U. S. Compiled St. 1901, p. 3395) is discretionary with the court and will not be interfered with by the appellate court unless it appears that there has been a clear abuse of discretion.

Fox v. Knickerbocker Eng. Co., 165 Fed. 442,
444.

The damages found by the master by reason of the sale of the 20 modified Parker machines was \$2,340.20.

It is clear from the evidence that this leaves a net profit to defendant Parker. He is still profiting by his wrongdoing. If the damages had been computed as contended for by complainant,—awarding the whole loss of complainant's profits on these machines,—the damages would have been \$3,949. Defendant Parker is still causing complainant expense by his litigious conduct. No wrongdoer could possibly be more stubbornly litigious.

In *Welling v. LaBan*, 35 Fed. 303, Judge Coxe says treble damages should be awarded where the defendant has been stubbornly litigious.

In *Carlock v. Tappan*, 5 Fed. Cas. 2412, it is held that where it appears that plaintiff is entitled to further damages or that without such award the defendant would be profiting by his wrongdoing, treble damages should be awarded.

See, further:

- Emerson v. Simm*, 6 Fish. P. C.;
- Lyon v. Donaldson*, 34 Fed. 789;
- Burdett v. Estey*, 3 Fed. 566;
- Fox v. Knickerbocker Co.*, 165 Fed. 442;
- Weston v. Empire Co.*, 155 Fed. 301;
- National Co. v. Robertson's Estate*, 125 Fed. 524;
- Kissinger-Ison Co. v. Bradford Co.*, 123 Fed. 91;
- Morss v. Union Co.*, 39 Fed. 469;
- Stimson v. R. R. Co.*, 1 Wall Jr. 164;
- Whittemore v. Cutler*, 1 Gall. (U. S.) 478;
- Evans v. Helleck*, 3 Wash. (U. S.) 408;

Livingston v. Jones, 3 Wall. Jr. 330;
Seymour v. McCormick, 16 How. 48;
Robinson on Pats., Secs. 953 and 1069;
Clark v. Chase, 119 U. S. 322;
Topliff v. Topliff, 145 U. S. 156.

It has been held that the court should take into consideration the fact that complainant has lost the interest on what he would have made (the damages) had defendant not appropriated his business. In this case such interest would amount to 35 per cent of the damages on the Parker patent type and to 14 per cent of the damages on the modified type, due to the long time complainant has been compelled to continue this litigation before securing a settlement.

National Co. v. Elsas, 81 Fed. 197; aff. 86 Fed.
917.

In Peek v. Fame, 9 Blatchf. 194, Judge Woodruff said: "The damages ought to be increased by a sum sufficient to cover the expenses of the trial, and something more for the time and trouble of the plaintiffs."

In Russel v. Place, 9 Blatchf. 173, the damages were increased to indemnify the plaintiffs from loss by reason of the expense of litigation. In Parker v. Corbin, 4 McLean 462, the damages were increased so as to cover the plaintiff's expense in counsel fees.

The event of this litigation is to leave the complainant a great loser by the infringements of these defendants. If a further sum of \$10,000 were awarded by this court, complainant would not even then be in the

same position as though defendants had respected and not infringed the patent in suit. This is not idle talk. The record proves these facts.

The complainant has expended thousands of dollars and a great time on this litigation during the six years it has been pending. This is the third time the case has been in this court. Defendants have once attempted to secure a full hearing in the Supreme Court, thus putting that additional expense on the plaintiff. The fault lies with the defendants,—not with plaintiff. Defendants are the wrongdoers and should not be permitted to profit by their wrongdoing.

Respectfully submitted,

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